

02-11-02

A

GRAYCARY. TECHNOLOGY'S LEGAL EDGE<sup>SM</sup>

4365 Executive Drive, Suite 1100  
 San Diego, CA 92121-2133  
 www.graycary.com  
 OJ 858-677-1456  
 FJ 858-677-1465

10/07/1976  
 02/05/02  
 10/07/1976  
 02/05/02

FEBRUARY 5, 2002

Attorney Docket No.: REGEN1250-6

**Box PATENT APPLICATION**

Commissioner for Patents  
 Washington, D.C. 20231

Presented for filing is a new continuation patent application of:

Applicant: Roger Y. Tsien; James S. Remington; Andrew B. Cubitt; Roger Heim; and Mats F. Ormo

Title: LONG WAVELENGTH ENGINEERED FLUORESCENT PROTEINS

The is a continuation application and the parent application, serial number 09/465,142 was assigned of record to The Regents of the University of California by virtue of an assignment submitted in the parent application, serial number 08/974,737 to the Patent and Trademark Office for recording on September 17, 1998 at Reel 9482, Frame 0206; to Aurora Biosciences Corporation, on September 21, 1998 at Reel 9382, Frame 0279 and to State of Oregon Acting by and Through the State Board of Higher Education on Behalf of The University of Oregon, on September 21, 1998 at Reel 9382 and Frame 0316.

Enclosed are the following papers, including all those required to receive a filing date under 37 CFR § 1.53(b):

	<u>Pages</u>
Specification	51
Claim(s)	4
Abstract	1
Declaration (copy from grandparent)	4
Drawing(s)	7
Assignment (copy from grandparent)	3

EXPRESS MAIL number: EV 047 295855US

Date of Deposit February 5, 2002

I hereby certify that this paper is being deposited with the United States Postal Service "EXPRESS MAIL Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to BOX PATENT APPLICATION, Commissioner for Patents, Washington, D.C. 20231.

*Mikhail Bayley*  
 Mikhail Bayley

SILICON VALLEY  
 LA JOLLA

SAN DIEGO

SAN FRANCISCO

AUSTIN

SACRAMENTO

SEATTLE

REGEN1250-6  
Box Patent Application  
February 5, 2002  
Page Two

Enclosures:

- Copy of Declaration for U.S. Application Serial No. 08/911,825 (4 pages); and
- Patent Data Sheet (3 pages);
- Preliminary Amendment (6 pages);
- Permission to Use Sequence Listing (2 pages);
- Sequence Listing Paper copy (4 pages);
- Assignment to the Regents of the University of California from USSN 08/911,825 (3 pages);
- Copy of PTO 1449 Form from an Information Disclosure Statement filed on December 16, 1999 for USSN 08/974,737 (3 pages);
- Check in the amount of \$370.00;
- Return Postcard.

This application is a continuation application and claims the benefit of priority under 35 USC § 120 of U.S. application serial no. 09/465,142, filed on December 16, 1999, which is a continuation of U.S. application serial no. 08/974,737, filed on November 19, 1997, now U.S. Patent No. 6,077,707, which is a continuation of U.S. application serial no. 08/911,825, filed on August 15, 1997, now U.S. Patent No. 6,054,321, which is a continuation-in-part of U.S. application serial no. 08/706,408, filed on August 30, 1996, now U.S. Patent No. 6,124,128, which claims priority under 35 USC § 119 of U.S. application serial no. 60/024,050, filed on August 16, 1996, all of which are incorporated by reference in their entirety in the disclosure of this application.

Preliminarily, on page 1 of the specification, before line 1, insert--This application is a continuation application and claims the benefit of priority under 35 USC § 120 of U.S. application serial no. 09/465,142, filed on December 16, 1999, which is a continuation application serial no. 08/974,737, filed on November 19, 1997, now U.S. Patent No. 6,077,707, which is a continuation of U.S. application serial no. 08/911,825, filed on August 15, 1997, now U.S. Patent No. 6,054,321, which is a continuation-in-part of U.S. application serial no. 08/706,408, filed on August 30, 1996, now U.S. Patent No. 6,124,128, which claims priority under 35 USC § 119 of U.S. application serial no. 60/024,050, filed on August 16, 1996, all of which are incorporated by reference in their entirety in the disclosure of this application.--

Basic filing fee	\$	370.00
Total claims in excess of 20= 3 times \$18 .00	\$	.00
Independent claims in excess of 3: 1 times \$84.00	\$	.00
Multiple dependent claims	\$	.00

Gray Cary Ware & Freidenrich LLP

REGEN1250-6  
Box Patent Application  
February 5, 2002  
Page Three

Total filing fee: \$ 370.00

Enclosed is a check in the amount of \$370.00 to cover the fees associated with this submission. However, the Commissioner is hereby authorized to charge any deficit, or credit overpayment, to Deposit Account No. 50-1355.

If this application is found to be INCOMPLETE, or if a telephone conference would otherwise be helpful, please call the undersigned at (858) 677-1456.

Kindly acknowledge receipt of this application by returning the enclosed postcard.

Please send all correspondence to:

Lisa A. Haile, Ph.D.  
Gray Cary Ware & Freidenrich LLP  
4365 Executive Drive, Suite 1100  
San Diego, CA 92121-2133  
Telephone: (858) 677-1456  
Facsimile: (858) 677-1465

Very truly yours,

GRAY CARY WARE & FREIDENRICH LLP



Lisa A. Haile, Ph.D.  
Registration No. 38,347

02/5/02  
Date

Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Tsien, et al.

Parent Application No.: 09/465,142

Parent Filed: December 16, 1999

Application No.: Unassigned

Filed: February 5, 2002

For: LONG WAVELENGTH ENGINEERED  
FLUORESCENT PROTEINS

) Group Art Unit: Unassigned

)

) Examiner: Unassigned

)

) CERTIFICATE OF MAILING BY "EXPRESS MAIL"

)

) "EXPRESS MAIL" MAILING LABEL NO. EY04729585SUS

)

) DATE OF DEPOSIT: February 5, 2002. I HEREBY CERTIFY THAT THIS PAPER OR

) PIECE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE

) "EXPRESS MAIL POST OFFICE TO ADDRESSEE" SERVICE UNDER 37 C.F.R. 1.10

) ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE ASSISTANT

) COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231

)

) Michael Bayley

) (TYPED OR PRINTED NAME OF PERSON MAILING PAPER OR FEE)

) *Michael Bayley*

) (SIGNATURE OF PERSON MAILING PAPER OR FEE)

Commissioner for Patents  
Washington, D.C. 20231

**PERMISSION TO USE SEQUENCE LISTING**

Sir:

The above-identified patent application lacks a substitute paper copy of the Sequence Listing for inclusion into the Specification, as well as a computer readable form of the Sequence Listing. Applicants respectfully direct the attention of the Office to the following:

1. A complete paper copy of the Sequence Listing is to replace the existing Sequence Listing and is to be inserted following the Abstract on page 53 and before the drawings. Please insert the Sequence Listing beginning with page 1 and numbering consecutively thereafter. This paper copy is identical to the paper copy of the Sequence Listing which is included in the Specification of the grandparent priority patent; to wit, U.S. Patent Application Serial No. 08/974,737 (the "737 application").

2. A computer-readable form of the Sequence Listing identical to the paper copy of the Sequence Listing is on file in the '737 application. Pursuant to 37 CFR §1.821(e) I, reference to the computer-readable form on file in the '737 application is hereby made, which computer-readable form was filed in the '737 application on November 19, 1997. Said computer-readable form is identical to both the paper copy of the Sequence Listing on file in the '737 application and the paper copy of the Sequence Listing submitted in the present application.

Applicants submit that the foregoing satisfies the requirements of Rule §1.821.

If there are any questions regarding this response, the Office is invited to contact the undersigned.

It is understood that this perfects the application and no additional papers or filing fees are required. If there are any other charges, or any credits, please apply them to Deposit Account 50-1355.

Respectfully submitted,



Lisa A. Haile, Ph.D.  
Registration No. 38,347  
Telephone: 858-677-1456  
Facsimile: 858-677-1465

Dated: February 5, 2002

GRAY CARY WARE & FREIDENRICH LLP  
4365 Executive Drive, Suite 1100  
San Diego, CA 92121-2133